



UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT: Petkovsek EXAMINER: M. Henderson
SERIAL NO.: 09/394,228 GROUP ART UNIT: 3722
FILING DATE: Sept. 13, 1999 ATTY. DKT. NO.: USA-P-99-012
INVENTION: "INTEGRAL SPECIAL SERVICE MAILING ASSEMBLY AND A
METHOD FOR USING THE SAME"

Asst. Commissioner for Patents
Washington, D.C. 20231

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APPELLANT'S REPLY BRIEF

S I R:

This Reply Brief is submitted in response to the Examiner's Answer dated February 13, 2002. In the Examiner's Answer, the arguments presented in the Appeal Brief filed January 15, 2002 were not found persuasive by the Examiner. Additionally, the Examiner raised two new points of argument in the Examiner's Answer. Namely, the Examiner alleges that Appellant has not defined what "special service" entails and that Appellant "seems confused with equating the claim limitation 'the shading and printing are a single color' with the argument 'to shade and print the label with a single color.'"

In the Examiner's Answer, the Examiner stated that "Since appellant has not defined what 'special service' entails in claims 1 and 9, the examiner has interpreted 'special service' in its broadest sense. A broad definition of a 'special service' is indicated in Appellant's arguments (Page 14, lines 1-4) as well." Concerning the prior art, the Examiner stated that "Walz does indeed disclose a postcard integrally formed with a designator

section, wherein the designator section is indicative of a special service."

In view of the new argument presented by the Examiner regarding the definition of a "special service", by this Reply Brief, Appellant argues the patentability of Claim 11 separately and apart from its parent Claim 9. More specifically, Claim 11 requires a method for preparing a mailpiece for delivery by a special service comprising the step of printing information on the return postcard relating to delivery of the mailpiece by a special service. By arguing the patentability of Claim 11 separately and apart from Claim 9, Appellant is not abandoning any argument previously made regarding Claim 9.

Appellant submits that a special service relates to the type of delivery of a mailpiece, as required by Claim 11. Various types of delivery exist for delivering a mailpiece. Further, Walz teaches a designator section for receiving an address to which the item is to be mailed and areas for receiving signatures. Walz does not teach a method for preparing a mailpiece for delivery by a special service comprising the step of printing information on the return postcard relating to delivery of the mailpiece by a special service as required by Claim 11 of the present invention. Therefore, Appellant submits that Claim 11 is patentably distinct from Walz or any art of record, taken singly or in combination. Appellant further submits that Claim 11 is now in condition for

allowance.

Regarding the Examiner's second new point of argument, Appellant respectfully submits that the phrase "wherein the shading and printing are a single color", as provided in Claims 1 and 9, requires the shading and printing on the label to be the same color. Claims 1 and 9 require "shading and printing wherein the shading and printing are a single color". Claims 1 and 9 do not require shading in one single color and printing in another single color, as the Examiner suggests. Appellant submits that Claims 1 and 9 require the shading and printing to be a single color.

Additionally, Claims 1 and 9 require a label "wherein the shading and printing are a single color." Appellant submits that the claim specifically defines a subject as "shading and printing." Those two things use the plural form of the verb, namely, "are", to connect to the object of the sentence, namely, "a single color." Therefore, both the shading and printing are a single color as clearly defined by the claims. Moreover, the claims simply cannot be randomly interpreted and/or contrary to the invention as set forth in Appellant's specification.

On the contrary, *Walz* teaches a form allowing different colors for shading and different colors for printing. The form in *Walz* teaches the shading in one color and the printing in another color. (See *Walz*, Col. 7, lines 43-46 and Col. 10, lines 64-67) *Walz* does not teach a label "wherein the shading and printing are a single

color" as required by Claims 1 and 9.

Appellant submits that one of ordinary skill in the art would never have been motivated to modify *Walz* in the manner suggested by the Examiner in formulating the rejection under 35 U.S.C. §103. The question under 35 U.S.C. §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements performed their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F. 2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

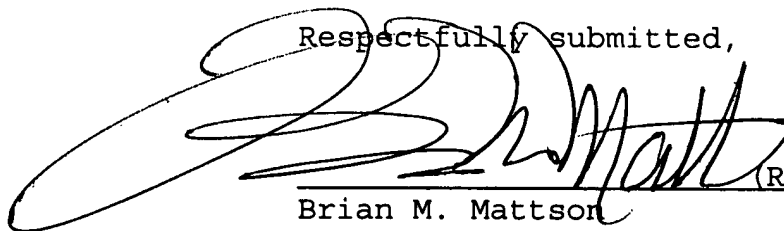
It is insufficient that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Walz* in mind, as

enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

In view of the foregoing remarks, Appellant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Appellant requests the Examiner to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

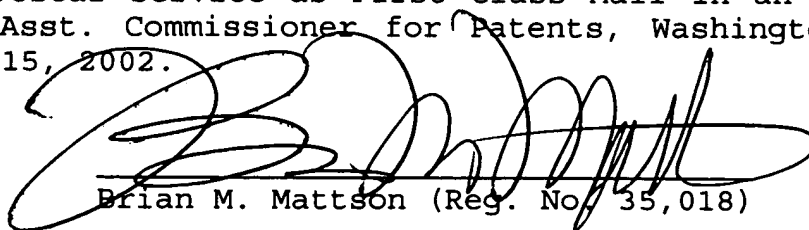


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CERTIFICATE OF MAILING

I hereby certify that this **REPLY BRIEF** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231 on April 15, 2002.



Brian M. Mattson (Reg. No. 35,018)